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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/896,231	06/29/2001	Arturo A. Rodriguez	A-7259	9416
5642	7590	12/29/2005	EXAMINER	
SCIENTIFIC-ATLANTA, INC. INTELLECTUAL PROPERTY DEPARTMENT 5030 SUGARLOAF PARKWAY LAWRENCEVILLE, GA 30044			LAYE, JADE O	
			ART UNIT	PAPER NUMBER
			2617	

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/896,231

Applicant(s)

RODRIGUEZ ET AL.

Examiner

Jade O. Laye

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-74 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-74 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

I. Applicant's amendments filed 10/26/05, have been entered and made of record. Accordingly, the objections and the 35 U.S.C. 112 rejection applied in the previous action have been withdrawn.

Response to Arguments

II. Applicant's arguments filed 10/26/05 have been fully considered but they are not persuasive. Accordingly, **THIS ACTION IS MADE FINAL**.

Applicant argues the Rodriguez reference (US Pat. Pub. No. 2005/0071882) is unavailable under 35 U.S.C. 102(e) because Arturo A. Rodriguez, a co-inventor of the reference and the instant application, invented the subject matter cited as the basis for the rejections in the previous action, and therefore, the reference is not by "another" and cannot form the basis of the 102(e) rejection. The underlying basis for this argument is found in the previous action stating on page 3:

"The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or (2) by an appropriate showing under 37 CFR 1.131."

Pursuant to this, Applicant has provided a declaration under 37 C.F.R. § 1.132 which asserts that Arturo A. Rodriguez is a "...co-inventor of the material cited from the '053 application [*Applied Reference*] as purportedly anticipating the claims of the present application." (Applicant's Declaration, Pg. 1). However, the declaration as a whole fails to provide the showing required to overcome the rejection because, primarily, Rodriguez only declares he is a "co-inventor" of the applied reference (and its cited portions) used in the previous rejection. Yet, the Examiner already knows this because Rodriguez is listed as a co-inventor, thus it is unclear as to why this argument furthers prosecution.

Here, it appears that Applicant and the Examiner have differing opinions as to what is required to overcome a 102(e) reference, thus the Examiner will explain his interpretation of the phrase "...This rejection under 35 U.S.C. 102(e) might be overcome either by (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another...". Applicant appears to argue that since Rodriguez is a co-inventor of the instant application and the applied reference (and cited portions used in previous action), the applied reference does not constitute an invention by "another" and thus should not be available under 102(e). However, Applicant is mistaken.

To the contrary, the Examiner interprets this phrase as atleast requiring a showing that Applicant himself and himself alone, invented the subject matter in the reference used to reject the instant application. Then, and only then, can Applicant argue the cited portions of the applied reference were not invented by "another." However, in the instant application, Applicant is only arguing that he was a "co-inventor" of the applied reference. Thus, the Examiner still

assumes that Dean F. Jerding also co-invented the cited portions used in the applied reference, therefore making it an invention by “another.” Moreover, the Examiner has no way of deciphering what portions of the applied reference were invented by Rodriguez ~~of~~ Jerding individually nor jointly and Applicant’s declaration does not shed any further light. Accordingly, Applicant has not sufficiently shown the cited portions of the applied reference used to reject the instant application were invented solely by Arturo A. Rodriguez, and therefore, the previous rejection is maintained.

Also, Applicant’s declaration raises some inventorship concerns. If Applicant is arguing that Rodriguez did in fact solely invent all the subject matter in the applied reference, the inventorship of the reference would be incorrect. On the other hand, if Jerding co-invented the cited portions of the applied references, the inventorship of the current application is incorrect. Either way, these issues should be further investigated.

In the event Applicant is able to provide a sufficient showing to overcome the 102(e) rejection, a similar rejection under 102(a) could be applied based upon the following references: WO 00/78031, Published in December 2000, also invented by Rodriguez and Jerding, and WO 00/78047, also published in December 2000 and also naming Rodriguez and Jerding as co-inventors. Upon a cursory review, each reference appears to disclose most of what Applicant is claiming in the present action. Also please note each reference is available under 102(a), therefore Applicant’s present 102(e) arguments would be unavailable. Moreover, 102(a) references do not fall under 35 U.S.C. 103(c)’s prohibition regarding commonly owned or assigned inventions, thus, each could be applied under 103(a).

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

III. Claims 1-4, 19, 20, 22, 23, 24, 62, 63, 64, 65, 67-69, 72, and 74 are rejected under 35 U.S.C. 102(e) as being anticipated by Rodriguez et al. (US Pat. Pub. No. 2005/0071882).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or (2) by an appropriate showing under 37 CFR 1.131.

As to claim 1, Rodriguez discloses a system comprising a memory, which is capable of downloading purchasable recordable media at various times. Also, the system is capable of dynamically reallocating excess capacity. (Pars. 7, 36, 38, 39, 47, 48, 52, 53, 61, and 62). Accordingly, Rodriguez et al anticipate each and every limitation of claim 1.

Claim 63 corresponds to the system claim 1. Thus, it is analyzed and rejected as previously discussed.

As to claim 2, Rodriguez further teaches allocation of bandwidth based upon historical bandwidth consumption. (Pars. 75 & 77). Accordingly, Rodriguez et al anticipate each and every limitation of claim 2.

As to claim 3, Rodriguez further teaches the allocation manager continually communicates with the network manager to dynamically allocate the bandwidth (i.e., allocates

according to current consumption). (Par. 86). Accordingly, Rodriguez et al anticipate each and every limitation of claim 3.

As to claim 4, Rodriguez further teaches the use of encryption techniques. (Par. 31). Accordingly, Rodriguez et al anticipate each and every limitation of claim 4.

As to claim 19, Rodriguez further teaches the system is in communication with a server. (Par. 13). Accordingly, Rodriguez et al anticipate each and every limitation of claim 19.

As to claim 20, Rodriguez further teaches the system stores popular movies (i.e., high demand) in the server. (Par. 73). Accordingly, Rodriguez et al anticipate each and every limitation of claim 20.

As to claim 22, Rodriguez further teaches the system downloads recordable media through the system server. (Par. 13). Accordingly, Rodriguez et al anticipate each and every limitation of claim 22.

As to claim 23, Rodriguez further teaches downloading media during low-demand periods (i.e., off-peak periods). (Par. 77). Accordingly, Rodriguez et al anticipate each and every limitation of claim 23.

As to claim 24, Rodriguez further teaches downloading media during low-demand periods (i.e., off-peak periods). (Par. 77). Accordingly, Rodriguez et al anticipate each and every limitation of claim 24.

As to claim 62, Rodriguez further teaches billing the customer for the media content. (Pars. 52 & 53). Accordingly, Rodriguez et al anticipate each and every limitation of claim 62.

As to claim 64, Rodriguez further teaches the use of a user interface (i.e., electronic programming guide). Accordingly, Rodriguez et al anticipate each and every limitation of claim 64.

As to claim 65, Rodriguez further teaches the use of multiple hub servers. (Fig. 1). Accordingly, Rodriguez et al anticipate each and every limitation of claim 65.

As to claim 67, Rodriguez further teaches the use of download options (i.e., download times, fee schedules, etc.). (Par. 36). Accordingly, Rodriguez et al anticipate each and every limitation of claim 67.

As to claim 68, it is clear from the above-discussed portions of Rodriguez, that his system is capable of providing media content immediately (i.e., on demand). Accordingly, Rodriguez et al anticipate each and every limitation of claim 68.

As to claim 69, Rodriguez further teaches the use of a calendar that lists various days in which programs can be downloaded. (Par. 36). Therefore, it is inherent a user would be able to download content with latency because they can select a later date at which to download the program. Accordingly, Rodriguez et al anticipate each and every limitation of claim 69.

As to claim 72, the entire disclosure of Rodriguez is directed to a video on demand system (i.e., offers impulse purchasing of movies). Accordingly, Rodriguez et al anticipate each and every limitation of claim 72.

As to claim 74, Rodriguez further teaches the use of unused bandwidth during off-peak periods. (Par. 64). Accordingly, Rodriguez et al anticipate each and every limitation of claim 74.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

IV. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haddad (US Pat. No. 5,555,441) in view of Hooper et al (US Pat. No. 5,414,455).

Note: The following claims depend from claim 1. In consideration of 103(c), Haddad will be applied to reject the limitations of claim 1. Accordingly, as to claim 1, Haddad discloses an audiovisual distribution system wherein recordable media can be downloaded at various times. (Abstract; Col. 2, Ln. 20-33). Haddad further teaches the system is capable of distributing the multimedia data at various times, such as off-peak hours, to more efficiently utilize the system hardware (i.e., reallocates excess infrastructure capacity). (Col. 2, Ln. 34-Col. 3, Ln. 5). Therefore, Haddad et al anticipate each and every limitation of amended claim 1.

Claim 63 corresponds to the system claim 1. Thus, it is analyzed and rejected as previously discussed.

Claim 5 recite the system of claim 1, wherein the first processor downloads recordable media content at a higher bit rate than the real-time playback rates. As discussed above, Haddad anticipates each and every limitation of claim 1, but fails to teach the limitations of claim 5. However, within the same field of endeavor, Hooper discloses a similar system wherein the media can be downloaded at a higher than real-time bit rate. (Col. 2, Ln. 41-48). Accordingly, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to

combine the systems of Haddad and Hooper in order to provide a system wherein the memory buffer is rapidly filled, so that requests to view program segments can be promptly filled.

V. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haddad in view of Greenwood et al. (US Pat. No. 5,568,181).

Claim 6 recites the system claim 1, wherein the first processor downloads recordable media content at a lower bit rate than the real-time playback rate. As discussed above, Haddad anticipates each and every limitation of claim 6, but fails to disclose the limitation of claim 6. However, within the same field of endeavor, Greenwood et al disclose a similar system wherein content is provided at a lower than real-time bit rate. (Col. 3, Ln. 5-6 & Col. 8, Ln. 20-23). Accordingly, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to combine the systems of Haddad and Greenwood in order to provide a system which is capable of delivering media to a wide area at a reasonable cost via a relatively slow network.

VI. Claims 7-18, 21, 26-50, and 53-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haddad in view of Hassell et al (US Pat. Pub. No. 2004/0128685) and further in view of Seazholtz et al. (US Pat. No. 5,812,786).

Claim 7 recites the system of claim 1, further comprising limitations too numerous to recite herein (please refer to claim sheet). As discussed above, Haddad anticipates each and every limitation of claim 1, and further discloses variable price, time, and download structures. (Col. 2, Ln. 20-Col. 3, Ln. 5). But, Haddad fails to disclose the remaining limitations of claim 7.

However, within the same field of endeavor, Hassell et al disclose a similar system comprising a secondary storage device, a plurality of portable mediums, and a user interface. (Abstract; Pars. 6-9). But, each reference fails to disclose variable download rates. However, within the same field of endeavor, Seazholtz et al disclose a similar system wherein the user is allowed to download data at variable rates. (Col. 2, Ln. 48-Col. 3, Ln. 20 & Col. 13, Ln. 63-Col. 14, Ln. 25). Accordingly, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to combine the systems of Haddad, Hassell, and Seazholtz in order to provide a system in which the user could build a program archive, wherein the user could selectively control the bit rate transmission of said programs.

[Note: The Examiner takes Official Notice that at the time of Applicant's invention, the use of buffers was well known in the art of telecommunications.]

Claim 8 recites the system of claim 7, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 7, and Haddad further teaches the use of passwords to verify user identity before the media is transmitted. (Col. 7, Ln. 44-48). Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 8.

Claim 9 recites the system of claim 7, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 7, and Haddad further teaches the user has various price and download options which can be chosen by the user. (Col. 2, Ln. 20-Col. 3, Ln. 5). Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 9.

Claim 10 recites the system of claim 7, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 7, and Haddad further teaches the system is in connection with an audiovisual library which provides videos when requested (i.e., on demand). (Col. 2, Ln. 9-Col.3, Ln. 5). Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 10.

Claim 11 recites the system of claim 10, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 10, and Haddad further teaches the user is allowed to request immediate or delayed download and that prices will vary accordingly. (Col. 2, Ln. 20-Col. 3, Ln. 5). Based upon this teaching, it would have been obvious to charge more for immediate download, as suggested by Haddad. Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 11.

Claim 12 recites the system of claim 10, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 10, and Haddad further teaches the user is allowed to request immediate or delayed (i.e., extended) download (which could be placed at anytime, including peak time) and that prices will vary accordingly. (Col. 2, Ln. 20-Col. 3, Ln. 5). Based upon this teaching, it would have been obvious to allow for a reduced download price if the user requested a delayed download time. Moreover, the Examiner takes Official Notice that it was notoriously known in the art at the time of applicant's invention to charge less for extended download times. (As evidenced by Aggarwal et al, US Pat. No. 6,631,413 Col. 4, Ln. 11-33).

Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 12.

Claim 13 recites the system of claim 10, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 10, and Haddad further teaches the system will allocate bandwidth (for example, shift demand from peak hours) in order to efficiently meet consumer requests. (Col. 2, Ln. 20-Col. 3, Ln. 5). Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 13.

Claim 14 recites the system of claim 10, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 10, and Haddad further teaches the system will utilized off-peak bandwidth (i.e., shift demand to off-peak hours) in order to efficiently meet consumer requests. (Col. 2, Ln. 20-Col. 3, Ln. 5). Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 14.

Claim 15 recites the system of claim 14, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the Examiner objected to this claim based upon its indefiniteness. Accordingly, the Examiner interprets the phrase "...during off repossessed unused bandwidth..." to denote "...during off peak, repossessed, or unused bandwidth...".

Also, as discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 10, and Haddad further teaches the system will shift most of the user demand to off peak hours and that prices would vary accordingly. (Col. 2, Ln. 20-Col. 3,

Ln. 5). This disclosure does suggest charging the user a lower fee for off peak downloads. Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 15.

Claim 16 recites the system of claim 14, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the Examiner objected to this claim based upon its indefiniteness. Accordingly, the Examiner interprets the phrase "...during repossessed unused bandwidth..." to denote "...during repossessed or unused bandwidth...".

As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 14, and Haddad further teaches the user is allowed to request immediate or delayed (i.e., extended) download and that prices will vary accordingly. (Col. 2, Ln. 20-Col. 3, Ln. 5). Based upon this teaching, it would have been obvious to allow for a reduced download price if the user requested a delayed download time. Moreover, the Examiner takes Official Notice that it was notoriously known in the art at the time of applicant's invention to charge less for extended download times. (As evidenced by *Aggarwal et al*, *US Pat. No. 6,631,413* Col. 4, Ln. 11-33). Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 16.

Claims 17 and 18 recite the system of claim 14, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the Examiner objected to this claim based upon its indefiniteness. Accordingly, the Examiner interprets the phrase "...during repossessed unused bandwidth..." to denote "...during repossessed or unused bandwidth...".

As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 14, and Haddad further teaches the user is allowed to request immediate (as

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recited in claim 17) or delayed (as recited in claim 18) download (which could be placed at anytime, including peak time) and that prices will vary accordingly. (Col. 2, Ln. 20-Col. 3, Ln. 5). Based upon this teaching, it would have been obvious to allow for a reduced download price if the user requested a delayed download time. Moreover, the Examiner takes Official Notice that it was notoriously known in the art at the time of applicant's invention to charge less for extended download times. (As evidenced by Aggarwal et al, US Pat. No. 6,631,413 Col. 4, Ln. 11-33). Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claims 17 and 18.

Claim 21 recites the system of claim 19, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 19, and the Examiner takes Official Notice that it was notoriously known in the art at the time of Applicant's invention to store new releases in video servers. Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 21.

Claim 26 recites the system of claim 7, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 7, and Hassell further discloses the use of a fast forward command (i.e., fast seek time), while Seazholtz further discloses the use of a high bit rate asymmetrical digital subscriber line. (Hassell Par. 40 & Seazholtz Col. 1, Ln. 60-64). Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 26.

Claim 27 recites the system of claim 7, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 7, and Hassell further discloses the system utilizes a hard disk memory. (Par. 86). Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 27.

Claim 28 recites the system of claim 7, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 7, and Hassell further discloses the system utilizes multiple portable media disks. (Par. 9, 19, & 89). Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 28.

Claim 29 recites the system of claim 7, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 7, and Hassell further teaches the system comprises a disc drive with write capability. (Par. 19). Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 29.

Claim 30 recites the system of claim 7, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 7, and Hassell further discloses the system utilizes multiple portable media disks (i.e., disk carousel). (Par. 9, 19, & 89). Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 30.

Claim 31 recites the system of claim 7, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and

Seazholtz disclose all limitations of claim 7, and Hassell further teaches the system comprises a disc drive with write capability. (Par. 19). Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 31.

Claim 32 recites the system of claim 7, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 7, and Hassell further teaches the system comprises a multiple disc drive with write capability. (Par. 19 & 89). Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 32.

Claim 33 recites the system of claim 7, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 7, and Haddad further discloses the system utilizes encryption keys. (Col. 5, Ln. 21-36). Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 33.

Claim 34 recites the system of claim 7, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 7, and Hassell further teaches the system utilizes an out-of-band channel to transmit programming data. (Par. 24). Based upon this disclosure, it would have been an obvious modification to use the out-of-band channel to also transmit program requests. Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 34.

Claims 35-38 recite the system of claim 7, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad,

Hassell, and Seazholtz disclose all limitations of claim 7, and Seazholtz further teaches the user is allowed to request media at a high and low bit rate (i.e., plurality of bit rates), respectively. (Col. 2, Ln. 47-64; Col. 3, Ln. 9-19; Col. 13, Ln. 63-Col. 14, Ln. 25). Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claims 35-38.

Claim 39 recites the system of claim 7, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 7, and Hassell further discloses the user is allowed to choose video formats (i.e., quality content options) for storage. (Fig. 14). Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 39.

Claim 40 recites the system of claim 7, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 7, and Hassell further discloses a plurality of recordable media screens. (Figs. 2-14). Moreover, the Examiner takes Official Notice that it was notoriously known in the art at the time to applicant's invention to provide the user with on-screen options to purchase media. (As evidenced by *LaJoie et al*, *US Pat. No. 5,850,218*). Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 40.

Claim 41 recites the system of claim 40, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 40, and Haddad further teaches providing the user with various downloading and pricing options. (Col. 2, Ln. 20-Col. 3, Ln. 5). Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 41.

Claim 42 recites the system of claim 41, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 41, and Haddad further teaches pricing media based upon the amount of time the user is on the system (i.e., bandwidth consumed), the time the user requests the program (i.e., time of day, week, etc), and the time the program will be downloaded (i.e., express delivery, long term, etc.). (Col. 2, Ln. 34-Col. 3, Ln. 5). The remainder of Applicant's limitations are obvious in light of the disclosed references recited herein. Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 42.

Claim 43 recites the system of claim 42, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 42, and Hassell further discloses the screen comprises pre-configured options. (Figs. 2-14). Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 43.

Claim 44 recites the system of claim 43, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 43, and Hassell further discloses the use of an interactive programming guide. (Figs. 4-13). Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 44.

Claim 45 recites the system of claim 44, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 44, and the Examiner takes Official Notice that it was notoriously known in this art at the time of applicant's invention to use icons in electronic

programming guides. (As evidenced by *LaJoie 5,850,218* Col. 19, Ln. 29-38 and all Figures). Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 45.

Claim 46 recites the system of claim 43, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 43, and Hassell further discloses the use of an interactive programming guide, which can also be considered a “service” guide. (Figs. 4-13). Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 46.

Claim 47 recites the system of claim 46, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 46, and the Examiner takes Official Notice that it was notoriously known in this art at the time of applicant’s invention to use icons in electronic programming guides. (As evidenced by *LaJoie 5,850,218* Col. 19, Ln. 29-38 and all Figures). Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 47.

Claim 48 recites the system of claim 46, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 46, and Hassell further discloses the use of an interactive programming guide, which categorizes the guide into a recordable media group (i.e., separate service entities). (Fig. 4). Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 48.

Claim 49 recites the system of claim 41, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 41, and the Examiner takes Official Notice that it was notoriously known in this art at the time of applicant's invention to provide the user with the on-screen option of purchasing programs. (As evidenced by *LaJoie 5,850,218* Fig. 28). Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 49.

Claim 50 recites the system of claim 41, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 41, and Hassell further discloses the use of an interactive programming guide, which can be implemented from processes occurring within the set top box (i.e., subscriber network application). (Par. 21). Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 50.

Claim 53 recites the system of claim 41, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 41, and Hassell further discloses the system will notify the user if the desired program is unavailable (i.e., the system will indicate that the user must insert another recordable media, thus indicating the program is presently unavailable on the inserted recordable media). (Par. 89). Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 53.

Claim 54 recites the system of claim 53, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 53, and Haddad further discloses the system allows the

user to choose purchase download options. (Col. 2, Ln. 20-Col. 3, Ln. 5). Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 54.

Claim 55 recites the system of claim 41, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 41, and Hassell further discloses the use of parental controls. (Par. 94 & Fig. 14). In the system as disclosed by Hassell, it is inherent that the parent insert some form of pin/code authorization. Moreover, Haddad also discloses the use of customer passwords. (Col. 7, Ln. 44-58). Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 55.

Claim 56 recites the system of claim 7, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 7, and Hassell further discloses the use of a remote control. (Par. 85). Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 56.

Claim 57 recites the system of claim 7, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 7, and Haddad further discloses the system database stores customer billing records. (Col. 7, Ln. 20-48). Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 57.

Claim 58 recites the system of claim 57, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 57, and Haddad further discloses the system database

stores customer billing records and authorization codes. (Col. 7, Ln. 20-48). It is inherent this database communicate with the program server, in order to facilitate transmission of the programs. Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 58.

Claim 59 recites the system of claim 58, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 58, and Hassell further teaches the system utilizes an out-of-band channel to transmit programming data. (Par. 24). Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 59.

Claim 60 recites the system of claim 57, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 57, and Haddad further discloses the system database stores customer billing records and authorization codes. (Col. 7, Ln. 20-48). It is inherent this database communicate with the program server, in order to facilitate transmission of the programs and that said communication occur periodically. Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 60.

Claim 61 recites the system of claim 60, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 60, and the Examiner takes Official Notice that it was notoriously known in this art at the time of applicant's invention to debit consumer accounts for various transactions (As evidenced by *Pond*, *US Pat. No. 5,329,590* Col. 8, Ln. 27-43).

Therefore, the combined systems of Haddad, Hassell, and Seazholtz contain all limitations of claim 61.

VII. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haddad in view of Hassell and further in view of Seazholtz as applied to claim 7 above, and further in view of Kitsukawa et al. (US Pat. Pub. No. 2001/0013125).

Claim 25 recites the system of claim 7, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 7, but fail to disclose the limitation of claim 25. However, within the same field of endeavor, Kitsukawa et al disclose a similar system which is capable of printing coupons which may be redeemed by the user. (Par. 56). Based upon this disclosure, printing a receipt would have been an obvious modification. Accordingly, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to combine modify the combined systems of Haddad, Hassell, Seazholtz, and Kitsukawa in order to provide a video on demand system which allows the user to print receipts/coupons, thereby providing the user with an incentive to take advantage of broadcast advertisements.

VIII. Claims 51 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haddad in view of Hassell and further in view of Seazholtz as applied to claims 7, 40, and 41 above, and further in view of Okamoto et al. (US Pat. No. 6,901,385).

Claim 51 recites the system of claim 41, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and

Seazholtz disclose all limitations of claim 41, but fail to disclose the limitation of claim 51. However, within the same field of endeavor, Okamoto et al disclose a similar system in which recordable media is offered on a trial basis. (Abstract; Col. 1, Ln. 15-18; Col. 2, Ln. 19-43). Therefore, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to combine the systems of Haddad, Hassell, Seazholtz, and Okamoto in order to provide a system wherein the user is allowed to purchase a trial program, thereby providing the user with the opportunity to view the a portion of the media before choosing to buy the entire media.

Claim 52 recites the system of claim 41, and further limitations which will not be recited (please refer to claim sheet). As discussed above, the combined systems of Haddad, Hassell, and Seazholtz disclose all limitations of claim 41, but fail to disclose the limitation of claim 52. However, within the same field of endeavor, Okamoto et al disclose a similar system in which recordable media is offered on a trial basis, while Haddad further discloses offering programming for a limited amount of time. (Okamoto Abstract; Col. 1, Ln. 15-18; Col. 2, Ln. 19-43 & Haddad, Col. 2, Ln. 20-33). Therefore, the combined systems of Haddad, Hassell, Seazholtz, and Okamoto contain all limitations of claim 52.

IX. Claim 66 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haddad in view of Wahl. (US Pat. No. 5,898,456).

Claim 66 recites the method of claim 63, and further limitations which will not be recited (please refer to claim sheet). As discussed above, Haddad anticipates each and every limitation of claim 63, but fails to disclose the limitation of claim 66. However, within the same field of

endeavor, Wahl discloses a tiered distribution network, in which the system is capable of re-routing distributed media to another server if the original server is unavailable. (Col. 4, Ln. 5-32). Accordingly, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to combine the systems of Haddad and Wahl in order to provide a tiered distribution network, whereby system reliability would be enhanced.

[Note: As for the limitation of claim 65, which is incorporated into claim 66, Haddad teaches the use of a audiovisual library (i.e., demand server). (Col. 2, Ln. 20-33). In light of this disclosure, one or more servers would simply be an obvious design choice based upon the amount of storage capacity each server has. Therefore, Haddad contains the limitation of claim 65.]

X. Claim 70 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haddad.

Claim 70 recites the method of claim 65, and further limitations which will not be recited (please refer to claim sheet). As discussed above, Haddad anticipates each and every limitation of claim 65, and further discloses pricing the media based upon bandwidth use (i.e., time of day, amount of time on system, etc.). (Col. 1, Ln. 46-Col. 3, Ln. 5). Although not explicitly discussed, this disclosure also suggests pricing based upon the availability of the server because higher prices could be charged if programs are requested during peak times (i.e., times when the server is more congested or less "available"). Therefore, the modified system of Haddad also discloses the limitation of claim 70.

XI. Claim 71 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haddad in view of Okamoto et al.

Claim 71 recites the method of claim 63, and further limitations which will not be recited (please refer to claim sheet). As discussed above, Haddad anticipates each and every limitation of claim 63, but fails to disclose the limitation of claim 71. However, within the same field of endeavor, Okamoto et al disclose a similar system in which recordable media is offered on a trial basis. (Abstract; Col. 1, Ln. 15-18; Col. 2, Ln. 19-43). Therefore, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to combine the systems of Haddad and Okamoto in order to provide a system wherein the user is allowed to purchase a trial program, thereby providing the user with the opportunity to view a portion of the media before choosing to buy the entire media.

XII. Claim 73 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haddad in view of Seazholtz.

Claim 73 recites the method of claim 63, and further limitations which will not be recited (please refer to claim sheet). As discussed above, Haddad anticipates each and every limitation of claim 63, but fails to disclose the limitation of claim 73. However, within the same field of endeavor, Seazholtz et al disclose a similar system in which media can be downloaded at variable bit rates. (Abst; Col. 1, Ln. 5-11; Col. 2, Ln. 48-64). Accordingly, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to combine the systems of Haddad and Seazholtz in order to provide a system in which the user could build a

program archive, wherein the user could selectively control the bit rate transmission of said programs.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Rodriguez et al, WO 00/78031, disclose a similar system for reallocating bandwidth in a VOD system.
- b. Jerding et al, WO 00/78047, disclose a similar system for reallocating bandwidth in a VOD system.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jade O. Laye whose telephone number is (571) 272-7303. The examiner can normally be reached on Mon. 7:30am-4, Tues. 7:30-2, W-Fri. 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner: Jade O. Laye
December 23, 2005.



VIVEK SRIVASTAVA
PRIMARY EXAMINER